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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,030	11/04/2003	Thomas L. Kelly	KES-0004	6735
23413	7590	04/03/2009	EXAMINER	
CANTOR COLBURN, LLP			A, PHI DIEU TRAN	
20 Church Street			ART UNIT	PAPER NUMBER
22nd Floor			3633	
Hartford, CT 06103				
NOTIFICATION DATE		DELIVERY MODE		
04/03/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

[usptopatentmail@cantorcolburn.com](mailto:usptopatentmail@cantorcolburn.com)

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/702,030	KELLY, THOMAS L.	
	<b>Examiner</b>	<b>Art Unit</b>	
	PHI D. A	3633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 15 January 2009.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-9 and 13 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-9, 13 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____.	6) <input type="checkbox"/> Other: _____ .

***Claim Objections***

1. Claim 13 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. “ substantialentirety” needs to be separated into two words.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Backenstow et al (4649686).

Backenstow et al shows a roof system with reduced hail/fastener impact damage characteristics comprising: a roof substrate having one or more layers of material (30); at least one top of at least one fastener(28, 36) exposed at a top surface of said substrate; a roof waterproofing membrane (24) positioned over said at least one fastener; and at least one-two individual piece of energy absorbing material (38, 41) positioned atop all forgoing elements and any-said waterproofing membrane to discretely cover said tops of each individual fastener of said at least one fasteners, said at least two pieces including a first piece(38) that is positioned and dimensioned directly over said top of said fastener, such that said first piece is positioned

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and dimensioned to cover a substantial entirety of no other roofing component, and said at least two pieces including a second piece that is affixed to a relative top of said first piece.

3. Claim 1, 4-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Backenstow et al (4649686).

Backenstow (figure 1) shows a method for reducing damage in a roof membrane of a roof substrate caused by hail/fastener impact comprising: locating fasteners(75) in a roof construction such that a top of said fastener is exposed at a top surface of the roof substrate (21), positioning at least two individual pieces of energy absorbing material(33, 40) to discretely cover each individual fastener of said fasteners whereby said fastener is completely covered by both of said at least two pieces, said at least two pieces including a first piece (40) that is positioned and dimensioned to directly contact said top of said fastener (figure 1), such that said first piece is positioned and dimensioned to cover a substantial entirety of no other roofing component; and affixing said first piece to said top of fastener; affixing a second piece(33) of said at least two individual pieces of energy absorbing material to a relative top of said first piece, positioning a roof waterproofing membrane( M) atop all forgoing elements, the one or more layer of roof material including insulation.

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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2. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuipers (4977720) in view of Best (5419666).

Kuipers (figures 1-2) shows a method for reducing damage in a roof membrane of a roof substrate caused by hail/fastener impact comprising: locating fasteners(3, 4) in a roof construction such that a top of said fastener is exposed at a top surface of the roof substrate (1, 2), positioning at least one individual piece of energy absorbing material(6) to discretely cover each individual fastener of said fasteners whereby said fastener is completely covered by the first piece, said at least one piece including a first piece (6) that is positioned and dimensioned to directly contact said top of said fastener (3, 4), such that said first piece is positioned and dimensioned to cover a substantial entirety of no other roofing component; and affixing said first piece to said top of fastener; positioning a roof waterproofing membrane (5) atop all foregoing elements, wherein said affixing is by adhering, wherein said adhering is by a self stick adhesive(the part of 98 which sticks) applied to said energy absorbing material, the one ore more layers insualitng insulation,

Kuipers does not disclose the step of providing a second piece of energy absorbing material, the step of affixing a second piece of said at least two individual pieces of energy absorbing material to a relative top of said first piece.

Best discloses the step of providing a second piece of energy absorbing material(24), the step of affixing a second piece of said at least two individual pieces of energy absorbing material to a relative top of said first piece.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Kuipers's teaching to show the steps of providing a second piece of energy

absorbing material, the step of affixing a second piece of said at least two individual pieces of energy absorbing material to a relative top of said first piece since it would provide secure protection of the fastener and thus strong attachment of the membrane to the substrate as taught by Best.

3. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuipers in view of Best as applied to claim 4 above and further in view of Alexander (5204148).

Kuipers as modified shows all the claimed limitations except for said energy absorbing material is a self-sticking cover tape composed of cured ethylene propylene diene monomer (EPDM) membrane with a butyl gum rubber bottom, wherein said cover tape is ethylene propylene diene monomer

Alexander (lines 12-26, column 5) discloses a tape composed of cured ethylene propylene diene monomer (EPDM) membrane with a butyl gum rubber bottom, wherein said cover tape is ethylene propylene diene monomer

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Kuipers's modified teaching to show the a tape composed of cured ethylene propylene diene monomer (EPDM) membrane with a butyl gum rubber bottom, wherein said cover tape is ethylene propylene diene monomer as taught by Alexander in order to provide for quick, effective sealing of the fasteners.

***Response to Arguments***

4. Applicant's arguments with respect to claims 1-9, 13 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art shows different roof sealing designs.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phi D A whose telephone number is 571-272-6864. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571-272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Phi D A/  
Primary Examiner, Art Unit 3633

Phi Dieu Tran A

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